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Sum

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,048	12/27/2001	Ernst Heinz	0093/000032	5170
26474	7590	07/13/2004	EXAMINER	
KEIL & WEINKAUF 1350 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036				AKHAVAN, RAMIN
		ART UNIT		PAPER NUMBER
		1636		

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/019,048	HEINZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ramin (Ray) Akhavan	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 19 April 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

An amendment filed 04/19/2004 is acknowledged and entered. The claims pending and under consideration are 1-10.

All objections or rejections of record not repeated herein are withdrawn. Where applicable, applicant's arguments with respect to rejections maintained will be included in the body of the rejection. This action is FINAL as the new grounds of rejection are made in response to applicant's amendment of the claims in the paper filed 04/19/2004.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 1. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This ground of rejection is modified to account for the newly added limitations of “85% homology” in the rejected claims.**

Applicant's invention is drawn to a process of preparing unsaturated fatty acids and an organism, where at least one isolated nucleic acid of a sequence encoding 6-desaturase activity is introduced into the organism. Furthermore, the invention is drawn to the same process/organisms where derivatives of SEQ ID NO: 1 and/or SEQ ID NO: 2 having at least 85 percent homology but without a substantial reduction of enzymatic action. In essence, applicant

is claiming a genus of sequences while a sufficient representative number of species within the genus have not been disclosed. This is a genus claim in terms of any sequence having at least 85 percent homology to SEQ ID NO: 1 and/or 2.

The written description requirement for a claimed genus may be satisfied by sufficient description of a representative number of species by actual reduction to practice, reduction to drawings or by disclosure relevant identifying characteristics, i.e. structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure or by a combination of such identifying characteristics sufficient to show applicant was in possession of the claimed genus.

The specification does not contain any examples of sequences that have said homology and have the prescribed activity. It is acknowledged that claims have a functional limitation, i.e. that the derivative must have a minimal level of  $\Delta 6$ -desaturase activity. (Spec. at 10, ll. 44-47). However, merely limiting 85 percent homologous regions to a functional limitation, where said sequences have not been clarified, does not meet the written description requirement. Thus the disclosure is not descriptive of the complete structure of a representative number of species, which the claims encompass, as one of ordinary skill in the art cannot envision all homologous sequences having the prescribed function, based on the teachings in the specification. In sum a representative number of species sufficient to convince the skilled artisan that applicant is in possession of the claimed genus has not been disclosed.

***Response to Argument***

Applicant's arguments filed 04/19/2004 have been fully considered but they are not persuasive. Applicant asserts that by amending the percent homology from 50 to 85%, the basis for the written description rejection is obviated, because one of ordinary skill in the art would be able to derive 85% homologous sequences. This argument is not found persuasive, because while an artisan would be able to use homology algorithms to derive specified homologous stretches, the artisan could not use such means to envision which of the vast number of homologous species identified actually contains the prescribed activity (i.e. desaturase activity). Such an assertion would be appropriate to obviate an enablement rejection, but not a written description rejection. Put another way, if applicant is correct, then any sequence identified with 85% homology would have to inhere the prescribed activity. This is not likely, which is exactly why one of ordinary skill in the art could not envisage a sufficient number of the species claimed to describe the broadly claimed genus. In sum, applicant cannot be deemed in possession of the claimed genus of proteins.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

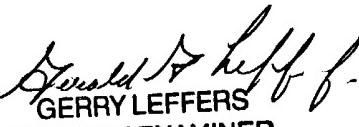
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramin (Ray) Akhavan whose telephone number is 571-272-0766. The examiner can normally be reached on Monday- Friday from 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GERRY LEFFERS  
PRIMARY EXAMINER